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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,909	09/30/2003	Timothy Brian Nestor	030627/267422	9010
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EXAMINER				
NGUYEN, PHU HOANG				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
04/08/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/674,909

**Applicant(s)**

NESTOR ET AL.

**Examiner**

PHU H. NGUYEN

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-10,12-17,19-26 and 28-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-10,12-17,19-26 and 28-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-10, 12-17, 19-26, 28-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jakob et al. (U.S Patent No. 5129408) in view of Perfetti et al. (U.S Patent No. 4924888).

Jakob et al discloses a cigarette and smokable material therefor which comprises, as seen in the Figures, a lighting end and a mouth end. An outer paper wrapping material 25 circumscribes a rod (corresponding to the claimed "inner portion") which includes a smokable material 25 which is comprised of some form of tobacco (i.e. expanded, reconstituted, laminae, stems, etc) in intimate contact with aerosol forming/casing materials, such as glycerin. As clearly evident from the drawings, the rod has a cylindrical shape and the lighting end is open to expose the rod such that the smokable material of the rod is positioned for lighting at the lighting end (See entire document and figs.). However, Jakob does not expressly disclose that the smokable material comprising greater than about 90 percent tobacco, based on the dry combined weight of the tobacco and any non-tobacco filler material. Perfetti discloses a smokable rod (10, fig. 1) comprising a lighting end and a mouth end (see fig. 1), an inner portion incorporating a smokable material (from about 80 to about 90 percent by weight of flue-

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cured tobacco material and 10 to about 20 percent by weight of Oriental tobacco material) (corresponding to the claimed "greater than about 90 percent tobacco, based on the dry combined weight of the tobacco and any non-tobacco filler material") (column 5, line 36-39), and glycerin (an aerosol forming/casing material) in intimate contact with a process tobacco material (can be a blend of flue cure tobacco material with processed tobacco stems, reconstituted tobacco material and Oriental tobaccos if desired as shown on column 5, line 7-13) (example 4, column 10, line 55-61). At the time of invention it would have been obvious to one having ordinary skill in the art to use smokable material (more than 90 percent tobacco by weight of tobacco and non-tobacco filler material) taught by Perfetti in the cigarette of Jakob for the taste of flue-cured tobacco and Oriental tobacco.

Furthermore, Perfetti discloses the cigarette paper wrap is available commercially; in example 5, the paper has an inherent permeability of 15 CORESTA (column 11, line 23-31). The wrapping materials can be processed in order to have a relatively high net permeability values such as about 50 to about 250 CORESTA units (column 7, line 20-30). Therefore, one of ordinary skill in the art at the time the invention was made can obtain the commercially available cigarette paper wrap and process it to a desired permeability value.

### ***Response to Arguments***

Applicant's arguments filed 1/09/2008 have been fully considered but they are not persuasive.

Applicant essentially argues that one of ordinary skill in the art would be disinclined to use greater than 90% tobacco material in the cigarette based on the teaching of Jakob patent (U.S Patent No. 5129408) and Perfetti patent (U.S Patent No. 492488) because to do so would clearly run counter to the express purposes of the Jakob patent. The Applicant directed to column 2 of the Jakob patent that describes the desirability of providing a good tasting cigarette that provides good smoking satisfaction, relatively low mainstream gas phase yields, relative low levels of incomplete combustion products, sustained smoldering during FTC smoking conditions, and which generates low levels of sidestream tar or visible sidestream smoke (see column 2, lines 20-27). It would be quite obvious to one of ordinary skill in the art that the use of the term "relatively" in this paragraph is intended to contrast the desired cigarette with conventional cigarettes which comprise predominately tobacco as the smokable filler portion. However, the Examiner found that the Perfetti patent also has the same desirability of providing a good tasting low "tar" cigarette that provides good smoking satisfaction, provides low main stream gas phase deliveries and low levels of visible sidestream smoke (see column 2, lines 43-51). Therefore, one of ordinary skill in the art at the time the invention was made would be inclined to combine the teaching of Jakob and Perfetti.

Applicant further argues that neither cited reference teaches the aerosol forming material is in intimate contact with a processed tobacco material that is processed such that at least a portion of a solvent soluble portion of the tobacco material is removed therefrom and such that the processed tobacco material is a substrate for the aerosol

forming material. However, Jakob discloses smokable filler materials can have at least one aerosol forming material and/or at least one flavoring agent incorporated therein and the aerosol forming materials can be provided as a portion of the binding agent (corresponding to the claimed "in intimate contact") (column 8, lines 6-20). Jakob also discloses tobacco extracts are processed forms of tobacco and are provided by extracting a tobacco material using a solvent such as water, carbon dioxide, a hydrocarbon, or a halocarbon, as well as various other organic and inorganic solvents (column 7, lines 39-46); therefore in this process at least a portion of a solvent soluble portion of the tobacco material is obviously removed via evaporation or during heating/drying and the processed tobacco is a substrate for the aerosol forming material when they come in intimate contact.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHU H. NGUYEN whose telephone number is (571)272-5931. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

P.N 4/2/2008

/Philip C Tucker/  
Supervisory Patent Examiner, Art Unit 1791